



IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1944

No. _____

JAMES W. WABER,

Petitioner,

vs.

MONTGOMERY WARD & CO., INCORPORATED,
AND UNITED STATES RUBBER COMPANY,

Respondents.

**BRIEF IN SUPPORT OF PETITION FOR THE WRIT
OF CERTIORARI.**

PREFACE.

The petitioner seeks allowance of the Writ of Certiorari principally because the Circuit Court of Appeals for the Seventh Circuit has enunciated a test of invention which has not been sanctioned by this Court, or any other court. Indeed, the novel test advanced by the Circuit Court of Appeals is contrary both to applicable decisions of this Court and to the stated intention of Congress. Petitioner seeks review at this time because no one other than the respondents infringes the patent in Circuits other than the Seventh Circuit. It is therefore unlikely that the petitioner may attain review from conflicting decisions directly involving the patent in suit.

OPINIONS BELOW.

The opinion of the trial Court was delivered on December 21, 1943. It is not reported but it appears in the record at pages 325 to 332. Pursuant to the opinion, counsel for the respondents prepared findings of fact, conclusions of law and final judgment, all of which were signed by the trial Court on January 10, 1944. They are not reported, but the findings of fact appear in the record at pages 334 to 337, the conclusions of law, at pages 337 to 338, and the final judgment, at page 338.

The opinion of the Circuit Court of Appeals was filed on May 19, 1945. It appears in the record at pages 464 to 471, and is reported in . . . F. (2d) . . . , and in 65 U. S. P. Q. 389.

JURISDICTIONAL STATEMENT.

The jurisdiction of this Court is believed to be conferred by U. S. Code Title 28, Sections 347 and 350. The judgment or decree sought to be reviewed is dated May 19, 1945 and this petition is presented within three months thereof.

The discretionary power of this Court is invoked upon the following grounds:

1. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent upon which the entire puncture sealing tube industry is founded, which industry (with the exception of the present respondents) is concentrated within the Seventh Circuit and which patent expires on June 2, 1948 (in less than three years) whereby a resulting conflict of decision is improbable.

2. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent on the ground that "a person trained and skilled in the (art) * * * , by studying and understanding (the) * * * prior art, could have duplicated the accomplishment of (the patentee)."

a. This holding presents a novel question of law which has never been decided by this court and one of general interest to the public. In principle, it is in conflict with decisions of this court.

b. This holding is contrary to the patent statutes and therefore is in direct conflict with applicable decisions of this court as constituting judicial legislation.

3. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a process patent comprising four steps upon the ground that it is anticipated by a prior art patent which does not disclose two of said steps. This holding is untenable because it is in direct conflict with applicable decisions of this court.

4. The Circuit Court of Appeals for the Seventh Circuit has stricken down a patent on the ground "assuming, as we think we must" that anticipation is present, although finding that the anticipating "language is not entirely clear." This holding is untenable because it is in direct conflict with applicable decisions of this court.

5. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent upon a broad construction of three prior art "paper" patents which never went into any useful or practical operation and from which nothing more was heard for a period of 15 years. A determination of invalidity based on such art is untenable because it is in conflict with the decisions of other Circuits Court of Appeals on the same matter and is probably in conflict with applicable decisions of this court.

6. The Circuit Court of Appeals for the Seventh Circuit has stricken down a patent as lacking invention contrary to established tests of invention. Failure to apply such tests is in direct conflict with applicable decisions of this court and with applicable decisions of other Circuit Courts of Appeals.

STATEMENT OF THE CASE.

The facts are stated in the petition under the heading *Summary and Short Statement of the Matter Involved* (Petition pages 2 to 6). For the sake of brevity, they are not repeated here. They are, however, amplified, with a more detailed study of the opinion of the Circuit Court of Appeals.

Superficially, the opinion correctly and accurately states many of the facts which are before this court upon this petition. However, it should be carefully scrutinized, because of its many improper conclusions and inferences both of fact and law. A careful reading of the opinion leaves one impressed with its faulty reasoning.

The petitioner, as did the Circuit Court of Appeals (R. 466), discusses the process claim, namely claim 2, since it claims the process used in making the product claimed by claims 3 and 6. No other claims are involved.

Claim 2 (R. 466, 355) describes the Waber method of making puncture sealing inner tubes for pneumatic tires. This method comprises four steps, as follows:

- (1) forming an endless tube of vulcanizable rubber whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used,
- (2)a expanding said tube by internal pressure,
- (2)b applying to the outer circumference of said tube while inflated a layer of plastic sealing compound,
- (3) covering the said compound with a layer of vulcanizable rubber which extends beyond the edges of the compound and contacts with the endless tube for adhesion thereto
- (4) and curing the entire tube structure in a mold whose cavity is substantially equal to the size and shape of the cavity of the tire casing in which said tube is intended to be used.

For better ease of understanding, step 2 of the analysis of the claim, as made by the Circuit Court of Appeals (R. 466-467), has been broken into two sub-divisions, 2a and 2b.

The opinion of the Circuit Court of Appeals specifically states that a feature of Waber's invention is that Waber forms an inner tube "of a predetermined size" (R. 465), namely to dimensions which "are slightly smaller than the cavity in the tire casing in which said tube is intended to be used" (R. 466). Waber then partially inflates the inner tube and applies to the outer circumference a layer of plastic puncture sealing material. Thereafter he covers the puncture sealing material with a layer of rubber and then cures the entire completed tube in a mold of substantially the size and shape of the inner contour of the casing in which the tube is to be used.

Although the Circuit Court of Appeals does not so specifically state, each of the four steps recited in its opinion is essential to the Waber invention. Without all of them, there can be no infringement; without them there can be no invention—they represent the features not found in the prior art. The complete combination of four steps is that which the Patent Office found to be patentable over the prior art.

In its discussion (R. 467-468, 470) of the Wallace patent 1,258,506 (R. 392) the court failed to recognize the importance of each of the steps of the Waber process although the Court does properly describe the Wallace disclosure. One exception, which apparently does not form the basis of its decision, is pointed out solely in the interest of accuracy. The court characterizes the intermediate "layer of protective material" (R. 467-8) as "a ply of compounded rubber" (R. 468). It, in fact, is a ply of "protective textile fabric" which may be "textile fabric frictioned with a suitable compound of rubber and coated on one side with the same" (R. 400, Col. 1, lines 44-50).

The opinion also purports to apply the disclosure to claim 2. The Court's discussion of the basic facts points out two substantial differences.

First, the court explains that Wallace "does not explain (the) relative size and shape" (R. 467) of the base tube formed in step 1. However, the court thereafter ignores that the dimensions of the base tube of Waber "are slightly smaller than the cavity in the tire casing in which said tube is intended to be used" (R. 466). And this forgetfulness immediately follows the court's recognition of the fact that the patent recites that it is a "feature" that the base tube "is formed of a predetermined size" (R. 465) and its recognition of Waber's contention that "the base tube has the size and form it will have in ultimate use." (R. 467).

Second, the opinion points out that in step 2, Wallace provides "a layer of puncture resistant material" instead of Waber's "layer of plastic sealing compound" (R. 467-468) and that Wallace's layer "served to prevent puncture" whereas Waber's, contemplated "the sealing of a puncture" (R. 468). Pertinently Wallace does not suggest that a plastic sealing compound may be substituted for his layer of protective textile fabric.

After correctly pointing out that at least two features required and claimed by Waber are not disclosed by Wallace, the court then concludes "Waber is anticipated by Wallace."

The opinion turns next to the Crombie patent (R. 468, 412) but does not specifically rely upon this patent as an anticipation. However, the opinion does infer that Crombie discloses the process of Waber for it recites that Crombie "discloses a process for constructing inner tubes" (R. 468). A study of the patent itself (R. 412) proves that

there is no anticipation of the Waber process. Raymond F. Ternes, the respondent's expert and the head of the Tire Division of the Patent Department of the United States Rubber Company (R. 55), was unable to apply the Crombie disclosure to claim 2; he stated "the Crombie patent obviously is not a method patent" and contains "no disclosure of how it is made" with an exception that it does mention that the whole is constructed to form a tube and vulcanized in the usual manner (R. 88).

The Court's next prior art discussion revolves about the Wildman patent (R. 469-470, 428). Wildman does not disclose steps 1 and 2 of the Waber process.

First, the Waber step 1 requires the forming of an endless tube whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is to be used. The Court shows that Wildman, on the contrary, "contemplated in the main the idea of building the plastic and extra layers on the tube while it was on a straight pole mandrel" (R. 469). The Wildman patent contains no disclosure as to size, but the opinion does not discuss this feature; it should have done so.

The Circuit Court of Appeals does not dispose of the petitioner's contention, "that Wildman does not have Waber's step of building the extra plies on a base tube while it is inflated in the ring shape it will have in use" (R. 469). It is true that the Court does discuss building the additional plies upon an inflated inner tube, but this is in respect to step 2—the Court failed completely to mention the ring shape. If there be any doubt as to the meaning of the specifications, this brief contains an Appendix B pages 43 to 45 which describes the detailed method of Wildman as contained in his original disclosure. This matter was cancelled out of the application on February 9, 1926 (page 18, Exhibit 19) to meet a Patent Office requirement (page 17,

Exhibit 19). It amplifies the language quoted in the Court's opinion. The details set forth in the Appendix B clarify any ambiguity, if any there be, in the summary analyzed by the Circuit Court of Appeals. The trial court received the file history in evidence because it "might aid in the interpretation of the patent" (R. 253). The portion of the specification set forth in the Appendix should be read in conjunction with the original drawings at pages 305 and 307 of the record.

With respect to step 2 the Court failed to express any positive opinion as to whether the tube is inflated, *i.e.* whether an air mandrel is used. Carefully the Court stated that the "language is not entirely clear" and then used qualifying words, "assuming, as we think we must", to reach the indefinite conclusion that additional plies "could be constructed" on an inflated tube (R. 469). Pertinently the Court did not find that Wildman taught this feature.

Further, the Court's discussion of Wildman's use of five plies instead of the three used by Waber states "the function to be performed was the same whether the tube be constructed of 3 or 5 layers" (R. 470). The petitioner does not rely upon this error of fact to support the petition for the writ. However there is no evidence in this record which supports the conclusion. The respondents did not even offer to take testimony on this point. In cross examination Waber was asked if it would be easier to build a tube leaving out the plies 2 and 4 and Waber replied that he didn't think it would make much difference except in the splicing (R. 244). Ease of building is a far cry from identity of function.

It is upon the above facts and with the above deficiencies in mind that the Circuit Court of Appeals reached the ultimate conclusion that "Waber is also anticipated by Wildman."

Patently, in view of the differences pointed out by the Court itself in discussing both the Wallace and the Wildman disclosures, the words "anticipated by" are used in the sense of "lacks invention over."

Hence it becomes very important to know what was the test of invention which the Circuit Court of Appeals applied. From earlier portions of the opinion, we are led to believe that the test was one applied strictly against the inventor, being based on "language * * * not entirely clear", "assuming", "as we think we must" and possibilities. We learn by further reading that the court applied the following negative test to reach its opinion that invention is lacking:

"We are of the opinion that a person trained and skilled in the making of tubes, by studying and understanding this prior art, **could have duplicated** the accomplishment of Waber" (R. 470).

The opinion of the court is silent with respect to the established objective rules of invention applied throughout the years, both by this Court and the several Circuits Court of Appeals. All of the standard rules have been discarded in favor of the Court's new subjective rule.

The Court concludes its opinion with a discussion of the commercial success of the Waber tube and an observation that it is unimpressed because Waber sold only 100,000 tubes during his peak year. As a "control" the Court selected ordinary non-punctureproof inner tubes with sales of 35 to 40,000,000; it ignored the fact that no puncture-resistant inner tube had ever been commercially successful prior to Waber (R. 220, this brief pages 39 to 40).

It is shown in the argument that there is unlikely ever to be any litigation elsewhere with a resulting conflict of decisions.

SPECIFICATION OF ERRORS.

The errors of the Circuit Court of Appeals by this Court are:

1. The Circuit Court of Appeals was not justified in holding a patent invalid upon the application of a negative test of invention that a person trained and skilled in the art, by studying and understanding the prior art, could have duplicated the accomplishment of the patentee.
2. The Circuit Court of Appeals erred in holding that the Wallace patent 1,258,506, which does not disclose two of four steps of the patent in suit, anticipates the Waber patent.
3. The Circuit Court of Appeals had no power to "assume" anticipation by a patent (the Wildman patent 1,601,013) where the "language is not entirely clear."
4. The Circuit Court of Appeals erred in construing broadly the disclosures of three "paper" patents, namely, the Wallace patent 1,258,506, the Crombie patent 1,498,017 and the Wildman patent 1,601,013.
5. The Circuit Court of Appeals erred in finding the Waber patent 1,808,091 invalid in view of the Wallace patent 1,258,506, the Crombie patent 1,498,017 and the Wildman patent 1,601,013.

ARGUMENT.

Summary.

The argument starts with a short statement urging that this Court should exercise its discretionary power to assume jurisdiction because it is unlikely that there will be a conflict of decision resulting from litigation elsewhere.

It next discusses the test negating invention where a skilled person "could have duplicated" the accomplishment of the patentee. The brief argues that such a test is contrary in principal with pertinent cases and that it constitutes improper judicial legislation by the Circuit Court of Appeals. It is shown that the test is unsound because it is contrary both to the intention of Congress and to the declaration of national policy enunciated by the late President Roosevelt's "National Patent Planning Commission."

The Circuit Court of Appeals additionally found anticipation where specific claim limitations were lacking in the prior art disclosures. It is shown that such a conclusion is contrary to applicable decisions of this Court and another Circuit Court of Appeals.

The brief further submits that a finding of anticipation which is based upon "language not clear" and assumptions is contrary to decisions of this Court and is therefore untenable.

It is then urged that "paper" patents are not entitled to a broad construction on the question of the patentability of a later successful patent.

The concluding portion of the argument demonstrates that the Circuit Court of Appeals should have applied established tests of invention as set forth in applicable decisions of this Court and of other Circuits Court of Appeals. If it had done so, it would have been impelled to find that Waber's efforts and accomplishments rose to the dignity of real invention.

1. A Resulting Conflict of Decision Is Improbable.

At the present time, other than for the instant infringement by United States Rubber Company, no one makes the

Waber type tube other than Waber himself (Petition, Exhibit A). Seiberling, who at one time made Waber type tubes (R. 22, 296), has stopped its acts of infringement (Petition, Exhibit A).

Thus, the entire industry, except for respondents' infringing acts, is now concentrated within the Seventh Circuit.

Further, the manufacture of pneumatic inner tubes is strictly regulated by government Executive Order, namely: *Restrictions on consumption, deliveries, inventories, use and importation of rubber and products thereof*. C. F. R. Title 32, Ch. 9, Part 4600, Section 4600.01 et. seq.

Section 4600.02 thereof provides that no person shall consume rubber raw materials "without first obtaining authorization to do so from the War Production Board." The War Production Board has seen fit to allow rubber for only a very small number of Waber type tubes for only such special service as heavy duty service for such things as trucks and taxicabs (R. 121). The "Rubber Board" didn't want to use as much rubber as was necessary to make the puncture proof inner tube except for commercial use (R. 35).

It is also pertinent that the patent expires on June 2, 1948, it having issued on June 2, 1931 (R. 352). This is a period of less than 3 years from today.

In view of the present limited market and the length of time it would naturally take for production tooling, it is improbable that any new infringers will crop up during the next 3 years in the Seventh or in any other Circuit.

In consequence, the words of this Court in *Schriber-Schroth Company v. Cleveland Trust Company*, (1938) 305 U. S. 47, at page 50, apply:

"litigation elsewhere with a resulting conflict of decision (is) improbable"

See also *Muncie Gear Works, Inc. et al. v. Outboard, Marine & Manufacturing Co. et al* (1942) 315 U. S. 759 where, page 766, it is said that "litigation in other Circuits, resulting in a conflict of decisions, is unlikely."

2. The Test of Invention Applied By the Circuit Court of Appeals Is Not Sanctioned By Authority.

The crux of the error of law made by the Circuit Court of Appeals and one which wholly substantiates this petition for the writ of certiorari is that the Circuit Court of Appeals applied a new and unsound test. It is one never suggested by this Court or contemplated by the Congress. The Circuit Court of Appeals states that invention is lacking because

"a person trained and skilled in the making of tubes, by studying and understanding this prior art, **could have duplicated** the accomplishment of Waber." (R. 470.)

In view of the attempts and failures of others to produce a puncture proof inner tube, with efforts extending over a period of nearly 40 years, during the last 12 of which the most important prior art patent, the Wallace patent, was available to the public, it is difficult to understand that such an opinion could be reached. But that difficulty does not supply the primary basis for this writ. It is the test itself which warrants complaint. The test is such a burden upon the patent system that it is not conceivable that any inventor will ever be able to meet it.

a.) *The new rule presents a novel question of law which, in principle, is in conflict with decisions of this court.*

The enunciation of this novel rule by the Circuit Court of Appeals is important both to the public and to this petitioner. If the rule be perpetuated, then it is obvious

that no patent could be valid. This new rule is so strict that it forbids application of the "Flash of genius" rule recently enunciated by this Court which latter rule has been the subject of much discussion because of its apparent strictness.

The test applied by the Circuit Court of Appeals is clearly analogous to the negative test suggested and condemned by this court in *O'Reilly, et al v. Morse, et al* (1853) 15 How. (56 U. S.) 62. The defendant in that case alleged that Morse was not the true and original inventor of the telegraph because Morse studied and obtained information from prior sources. The Supreme Court correctly denied the defense, stating, at page 111 as follows:

"Neither can the inquiries he made, or the information or advice he received, from men of science in the course of his researches, impair his right to the character of an inventor. No invention can possibly be made consisting of a combination of different elements of power, without a thorough knowledge of the properties of each of them, and the mode in which they operate on each other. And it can make no difference, in this respect, whether he derives his information from books, or from conversation with men skilled in the science. If it were otherwise, no patent, in which a combination of different elements is used, could ever be obtained. For no man ever made such an invention without having first obtained this information, unless it was discovered by some fortunate accident. And it is evident that such an invention as the Electro-Magnetic Telegraph could never have been brought into action without it. For a very high degree of scientific knowledge and the nicest skill in the mechanic arts are combined in it, and were both necessary to bring it into successful operation. And the fact that Morse sought and obtained the necessary information and counsel from the best sources, and acted upon it, neither impairs his rights as an inventor, nor detracts from his merits."

The Circuit Court of Appeals in the instant case goes even further than was suggested in the *Morse* case and holds a patent to be invalid if one skilled in the art **could have duplicated** the invention by a study of prior art sources. If a patent is not invalid where in fact the patentee **did study** the prior sources, there is no merit in a holding that a patent is invalid where he **could have duplicated** the invention by a study of the same sources.

The question which the Court really should have answered is whether one of ordinary skill in the art, before anyone had thought of the Waber invention, would have constructed a puncture sealing tube in accordance with Waber's teachings after seeing the Wallace disclosure and the many patents disclosing a plastic sealing compound. That he would not, is eloquently testified to by the fact that such disclosures had been a part of the public commons since at least 1918 and **no one did think of it except Waber**. It is easy after the problem has been solved to see the solution but that should not deprive the one who showed the way the status of an inventor.

In *Electric Storage Battery Co. v. Shimadzu, et al.* (1939) 307 U. S. 5, the Court granted *certiorari* because among other reasons, page 8, the case presented a question "which should be settled by this court."

b.) *The new rule is contrary to the patent statutes and therefore constitutes judicial legislation.*

Congress did not intend that the Patent Laws should be evaded by an infringer merely because someone else **could have duplicated** the invention. The intention of Congress was clearly expressed upon this very subject when the patent laws were codified in 1870. Congress looked at patents objectively not subjectively. Representative Jenckes was in charge of the passage of the codification in the House, and in explanation of the patent

system, which the code was designed to define and protect, he said, 93 Congressional Globe, page 2878 (April 21, 1870 issue):

“But why protect it at all, say many. If an invention had not been perfected by this patentee today it would have been at some subsequent time by some other inventor. Why not wait and let it be produced in course of time, according to the necessities of the art in which it is developed, and without expense to the public? This objection touches precisely the point of the whole matter, and affords the best argument for the patent laws. It admits that invention is a question of time, and that the results of invention are desirable and valuable. The patent laws offer a premium upon the earliest time. If it be known that any art or manufacture could be improved by invention in any particular, the question is, is it likely that such improvement will be made sooner by protection of the inventor, or will it be delayed indefinitely without such protection? The solution of this question does not rest in speculation. The history of inventions determines it. The loom is as old as civilization, but the power-loom was perfected under the stimulus and protection of the patent laws. So was the machinery for spinning. The philosophy of steam may have been ancient, but the steam-engine is a creature of the patent laws.

• • • • • •

When it is said that an invention would have been made at some time if not at the time when it was made, without the stimulus of the patent laws, who can tell at what time? When would any modern invention that might be named, the sewing-machine, for instance, have been produced if the inventors had not expected a profit upon it?”

The above language and the entire tenor of Representative Jenckes analysis (Appendix C, pages 46 to 58) illustrates that the Congress intended to test invention objectively rather than subjectively.

The report of the National Patent Planning Commission, 78th Congress, 1st Session, House Document No. 239, page 6, varied not in the slightest from the original stated intention of Congress, for it recommended

“the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished.”

Representative Jenckes had stated:

“The patent laws offer a premium on the earliest time.”

Both now and then an objective approach to the term “invented” is sound public policy. The new test of the Circuit Court of Appeals is unsound under any standard of judgment.

The 1870 code contained substantially the provision now incorporated in U. S. Code, Title 35, Section 69. That section does not provide the defense that a patent should be invalid if a skilled mechanic **could have duplicated** the invention. Furthermore the portion entitling a person to a patent, now U. S. Code, Title 35, Section 31, requires merely that the invention be “not known or used by others in this country * * * and not patented”; it does not provide the harsh rule applied in the instant case by the Circuit Court of Appeals.

In effect, the Opinion of the Court has taken the Second defense enacted by Congress in U. S. Code, Title 35, Section 69 and has rewritten it entirely. The Second defense provides:

“That he (the patentee) surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same;”

The defense, as rewritten by the Circuit Court of Appeals for the Seventh Circuit, now reads:

"That he (the patentee) obtained the patent for, that which could have been duplicated by another."

Note that "was in fact invented" is the very antithesis of "could have been duplicated". Further, the Circuit Court of Appeals ignores the statutory limitations "surptitiously or unjustly" and the limitation that the other person "was using reasonable diligence in adapting and perfecting the same."

Thus, the Circuit Court of Appeals, has applied a standard of invention denied by the Supreme Court and wholly beyond the expressed intention of the Congress. By imposing upon the patent system burdens which the legislature has not provided, the Circuit Court of Appeals has stepped beyond the Constitution, contrary to applicable decisions of this court.

In *Electric Storage Battery Co. v. Shimadzu, et al.* (1939) 307 U. S. 5, the defendant in a patent infringement suit requested relief which was not plainly stated in the statute. At page 14 the Court said:

"We cannot thus rewrite the statute. * * * Congress has not seen fit to amend the statute in this respect and we must assume that it has been satisfied with, and adopted, the construction given to its enactment by the courts."

In *A. C. Frost & Co. v. Coeur D'Alene Mines Corp.* (1941), 312 U. S. 38, plaintiff brought an action under the Security Act of 1933 and requested relief for an act not specifically provided for in the Securities Act. At page 43 the court said:

"Courts have often added a sanction to those prescribed for an offense created by statute where the cir-

cumstances fairly indicated this would further the essential purpose of the enactment; but we think where the contrary definitely appears—actual hindrance indeed of that purpose—no such addition is permissible.”

In the instant case the new rule of the Circuit Court of Appeals is an actual hindrance to the purpose of the legislature.

3. The Observation By The Circuit Court of Appeals That the Wallace Patent Anticipates the Waber Patent Is Contrary To Applicable Decisions of This Court.

The Circuit Court of Appeals observed that “Waber is anticipated by Wallace” (R. 468). The decision is untenable because it is in direct conflict with applicable decisions of this Court. Anticipation and infringement are each subject to the same rules. That which would not infringe does not anticipate.

This brief is supplemented with “Appendix A,” page 42a. “Appendix A” is a side by side correlation of the elements of Claim 2 and the disclosures of the three principal prior art patents. For the sake of convenience, the disclosures of the prior art patents have been slightly reworded to correspond as much as possible to the language of the Claim 2 under consideration. It is believed that this rewording has been wholly accurate; all doubts have been resolved in the respondents’ favor.

For ease of comparison, the Appendix incorporates both bold face type and italics. The normal type indicates Waber features found in the prior art disclosures; the bold face type indicates Waber features that are not found in the prior art disclosures; and the type in italics, within parenthesis, represents undesirable features of the prior art disclosures which Waber has eliminated.

A glance at Appendix A conclusively shows that none of the prior art disclosures can possibly be construed either to anticipate or to infringe the Waber Claim 2.

For instance, referring to Wallace, we find that Wallace does not use a base tube "slightly smaller than" the intended cavity. The opinion states that Wallace "does not explain its relative size and shape" (R. 467). At best, the Wallace base tube is substantially smaller, being two-thirds the size of the cavity (R. 400, Col. 1, line 13; R. 418, Col. 1, lines 29-32; Appendix A, page 42a, footnote 4). With respect to steps 2 and 3 Wallace uses a protective textile fabric instead of "plastic sealing compound."

Petitioner also points out that the respondents did not offer any evidence that there is an equivalency between "slightly smaller" and "one-third smaller," or between "plastic sealing compound" and "protective textile fabric." The respondents had the burden of proving such a fact if it be true. Failure of proof can not be supplied by conjecture or argument. Wallace's lack of success argues that there is no equivalency here.

These differences would prevent infringement, likewise they do prevent anticipation.

The elements of a claim and their limitations must be regarded as material upon the question of infringement. *I. T. S. Co. v. Essex Co.* (1926), 272 U. S. 429, 444.

The failure of the Circuit Court of Appeals to apply claim limitations is also contrary with the decision of another Circuit Court of Appeals on the same matter. In *Philadelphia Rubber Works Co. v. Portage Rubber Co.* (C. C. A. 6, 1917), 241 Fed. 108, 110, the court said:

"* * * limitations as to degree and time in the process correspond to the limitations as to shape, size, or location in the mechanical combination. If these

limitations as to shape, size, and location are essential to the new result reached, they form a necessary part of the invention; but, whether necessary or not, they cannot be disregarded if they have been inserted to meet the demands of the Patent Office, or if they have been deliberately and with industry adopted, even though voluntarily."

There is no question that anticipation and infringement are each subject to the same rules.

In *Commercial Manufacturing Company v. Fairbank Canning Company* (1890), 135 U. S. 176, the Court discussed the question of anticipation, and at page 194 the Court applied the rule that a patent is anticipated if a manufacture "by the precise process" described in the prior patent would be an infringement.

In *Knapp v. Morss* (1893), 150 U. S. 221, the Court applied the rule, at page 228, that if the prior patents were subsequent in date to that of the patent in suit, they would constitute an infringement thereof, there was anticipation because the rule, well established, is "that which infringes, if later, would anticipate if earlier." This latter rule is repeated in *Miller v. Eagle Manufacturing Co.* (1894), 151 U. S. 186 at page 203.

4. The Determination By The Circuit Court of Appeals That the Wildman Patent Anticipates the Waber Patent Is Contrary To Applicable Decisions of this Court.

The Court concluded that "Waber is also anticipated by Wildman" (R. 470). The conclusion is untenable. The Wildman patent does not disclose the "endless" tube required for step 1, nor does it disclose that the dimensions of the base tube are "slightly smaller than" the cavity in which the tube is to be used. It does not describe the air mandrel required by step 2 (a). Further, it requires a

splicing step to form the completed tube, which results in a five step process as compared with the four step process of Waber.

A holding of anticipation upon these facts is in conflict with the same decisions cited immediately above.

Further, the Court's conclusion is based on assumptions and conjecture as to the Wildman disclosure. The opinion relies upon anticipating "language * * * not entirely clear" (R. 469) and reached the conclusion of anticipation "assuming as we think we must." Certainly this language of the court proves that the Wildman disclosure is not in "such full, clear, and exact terms as to enable any person skilled in the art" to use Waber's method. For this reason the opinion of the Circuit Court of Appeals is in conflict with applicable decisions of this Court.

The rule with respect to anticipation is very aptly put in *Seymour v. Osborne* (1870), 11 Wall. (78 U. S.) 516, 555, wherein the court states the rule with respect to foreign publications and prior patents, stating that the rule is the same for each. This Court held that a patented invention cannot be superseded (anticipated)

"unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention. * * * Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use."

In *Gordon v. Warder* (1893), 150 U. S. 47, the Court held that a prior patent did not serve as an anticipation, although the specification in that case did contain a paragraph stating that it might be advantageous, in some cases,

to make the device claimed in the later patent. The Court pointed out that no means were there provided, or method pointed out, whereby such a desired result could be obtained (page 50).

Even if we were to combine the teachings of all three prior art patents, which of itself might be the act of invention, there still would be no anticipation. None of the prior art patents explains the relative size and shape of the base tube and explains that the dimensions of the base tube should be slightly smaller than the cavity of the tire casing in which this tube is intended to be used. Further, such combination for the purposes of anticipation is forbidden by *Bates v. Coe* (1878), 8 Otto (98 U. S.) 31 at page 48, where the Court held that:

“Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement.”

Imhaeuser v. Buerk (1879), 11 Otto (101 U. S.) 647, 660; and *Parks v. Booth* (1880), 12 Otto (102 U. S.) 96, 103-104 reiterate this principle.

In *Topliff v. Topliff and another* (1892), 145 U. S. 156, 161 it is said:

“It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions.”

It should be noted that this section on anticipation eliminates all discussion as to whether or not the elimination of the steps applying the additional 2 plies of Wildman affects the question of anticipation. Although no evidence was taken by the respondents, it is felt that there are sufficient other distinctions that the point need not be argued at this time.

5. A Broad Construction of Prior Art "Paper" Patents Which Never Went Into Any Useful or Practical Operation and From Which Nothing More Was Heard For a Period in Excess of 15 Years Is in Conflict With the Decisions of Other Circuits Court of Appeals and With Applicable Decisions of this Court.

The Circuit Court of Appeals sustained the respondents' defense of anticipation or lack of invention over the prior art. The defense sustained by the Circuit Court of Appeals rests upon the patents for improvements issued to Wallace, Crombie, and Wildman; which improvements were finally abandoned. They never went into any useful or practical operation, and nothing more was heard of them from the patentees or any other persons for a period in excess of 15 years.

Waber, who had been in the tire business since 1924 (R. 21), had never seen a successful tube made in accordance with these prior art teachings (R. 22, 220) and Ternes, the respondents' expert, had never seen a puncture sealing tube made in accordance with the teachings of Wallace (R. 86) Crombie (R. 88, 89), or Wildman (R. 89).

The finding of invalidity based upon such prior art is probably in conflict with applicable decisions of this court, and principally with dictum in *Whitely v. Swayne* (1868), 7 Wall. (74 U. S.) 685. At page 687 the court said:

"Clearly, if any other person had chosen to take up the subject of the improvements, where it was left

off by * * * (a patentee whose improvements were finally abandoned, which never went into any useful or practical operation, and from which nothing more was heard for a period of 6 years), he had a right thus to enter upon it, and if successful, would be entitled to the merit of them as an original inventor, for he is the first inventor, and entitled to the patent, who, being an original discoverer, has first perfected and adapted the invention to actual use."

Deering v. Winona Harvester Works (1894), 155 U. S. 286, involves the construction of a "paper" patent upon the analogous question of infringement. At page 295, the Court indicated that a "paper" patent is entitled to but a very narrow construction, stating:

"But in view * * * of the fact that his invention was of doubtful utility and never went into practical use, the construction claimed would operate rather to the discouragement than the promotion of inventive talent."

The opinion of the Circuit Court of Appeals, being based upon unsuccessful prior art, is also in conflict with decisions of other Circuit Courts of Appeals on the same matter including the following:

In *Williams Iron Works Co. v. Hughes Tool Co.* (C. C. A. 10, 1940), 109 F. (2nd) 500, 510, the court said:

"A prior patent which fails to solve the problem toward which the inventor's efforts are directed does not anticipate a subsequent patent which successfully solves the problem and effectually accomplishes the desired results."

In *Farmers' Manufacturing Co. v. Spruks Mfg. Co. et al.* (C. C. A. 4, 1904), 127 Fed. 691, the court discussed a prior art patent which had been issued for 29 years when the application of the patent in suit had been filed. At page 693, the court said:

“For nearly 30 years it had been on the public record without producing any effect on the art or trade of barrel making. It cannot be said that a patent for a device which fails to accomplish the desired end is an anticipation of one which successfully accomplishes it.”

In *Kings County Raisin & Fruit Co. et al. v. United States Consolidated Seeded Raisin Co.* (C. C. A. 9, 1910), 182 Fed. 59, the prior art patent, the Crosby patent, was issued in 1866 and the patent in suit, the Pettit patent, was issued in 1899. At page 62 the court said:

“The Crosby invention undoubtedly anticipates and describes the whole theory of the Pettit patent; but it does not appear ever to have been put to use, and there is no evidence that any machine was ever constructed under it. It is one thing to invent the theory of a machine. It is quite another thing to invent a successfully operating machine. A third of a century passed between the date of that patent and the date of the Pettit patent, and in that time the evidence is conclusive that raisin seeding was done by hand, and that seeding by machinery was an unknown art. The Pettit machine was the first to go into use, and it went into very extensive and successful use. * * *”

“It is probably unnecessary, on this appeal, to determine just what effect should be given to the Crosby patent as limiting the scope of the Pettit invention. It would seem that it was one of those unsuccessful and abandoned inventions which are held to have no place in the art to which they relate. In an analogous case, Mr. Justice Brown said: ‘His efforts in that direction must be relegated to the class of unsuccessful and abandoned experiments, which, as we have repeatedly held, do not affect the validity of a subsequent patent.’ *Deering v. Winona Harvester Works*, 155 U. S. 286, 302.”

In *Diamond Patent Co. v. S. E. Carr Co.* (C. C. A. 9, 1914) 217 Fed. 400, 405, the court said:

“The novelty of an invention is not negatived by a prior useless process or thing, nor is anticipation made

out by a device which might, with slight modification, be made to perform the same function. The invention must have been complete, and capable of producing the result. One should not be deprived of the results of a successful effort merely because someone else has come near it."

In *Babcock & Wilcox Co. v. Springfield Boiler Co., et al.* (C. C. A. 2, 1927) 16 Fed. (2nd) 964, 969, the court said:

"Prior patents, none of which solved the problem, can have no effect in anticipating, qualifying, or defeating the claims for patent protection of those whose subsequent effort produced success."

6. Established Tests of Invention Prove the Patentability of the Waber Contribution.

The Circuit Court of Appeals should have tested the presence of invention by the objective tests enunciated by this Court throughout the years. Had it done so, the Court would have been impelled to find that Waber's contribution was inventive.

In the interest of brevity, the facts showing the presence of invention will be stated summarily.

The rubber art is one in which small changes are important (*Encyclopedia Britannica*, 1945 Edition, Vol. 19, page 605; Vol. 7, page 743; *The Americana*, 1928 Edition, Vol. 23, pages 742-744; *Rubber Company v. Goodyear*, 9 Wall. 788, 793; *Diamond Rubber Co. v. Consolidated Tire Co.* 220 U. S. 429, 434, 440).

In the instant case, the principal prior art patent, that of Wallace, was available to the public since 1918 (R. 392). A plastic sealing compound between two layers of vulcanizable rubber is disclosed as early as the Armstrong patent of 1919 (R. 406). If there were no invention involved in discovering the Waber method, it seems peculiar that no one, except Waber, was able to make the discovery in the period since 1918-1919.

Waber's contributions were a step beyond the prior art and showed the public how to make a successful tube. First, Waber teaches that the base tube must be "slightly smaller" than the cavity of the tire casing (R. 466, 467). Second, Waber teaches that "plastic sealing compound" should be applied to a base tube which is inflated for use as an air mandrel (R. 466, 467). Third, Waber for the first time describes the complete combination of all four steps which are necessary for a successful tube and he gives the necessary details for each step (See claim 2, R. 466, 467). Thus, Waber has taught three things not found in any prior art patent. The respondents use them all.

These teachings of Waber have many practical accomplishments. Most important is that his was the first successful puncture sealing tube. As a result, Waber tubes last longer than regular tubes and may be used for from two to four casings (R. 48, 31, 32, 261). They may be driven 50,000 miles compared to 10,000-12,000 miles for the regular tube on trucks (R. 257). The period between inflations is reduced (R. 32, 260). Spare tires are eliminated (R. 261, 32). There are no flat tires to be changed (R. 260). A Waber tire can be driven from 500 to 1,500 miles with a puncture without losing air (R. 38, 147). They retain their balance and shape (R. 185, 32).

None of the prior art tubes had any of these advantages because no one had ever been able to make one successfully. The experts for both petitioner and respondent had never seen a successful prior art puncture sealing tube (R. 86, 88, 89, 22, 220).

A need and demand for a puncture sealing tire had long existed—it began with the first use of the pneumatic tube. Waber, himself, needed them in his business (R. 22). Prior to Waber, the art labored hard beginning in 1892 (R. 24, 7, 10) to solve this problem and to meet the public need. No one was successful (R. 22, 220, 24, 23, 86, 88, 89). Waber

examined 75 to 100 patents (R. 24) but found none he could use.

All of the efforts of those prior to Waber were failures. Ternes, the patent expert for the tire division of United States Rubber Company (R. 55) examined several thousand copies of patents; yet none of them was successful, for the United States Rubber Company found it necessary to infringe the Waber patent (R. 327-328, 337).

When Waber started to search for puncture proof tubes, he found none although he tried every place (R. 22). Today none of the prior art tubes is on the market (R. 220). Others had tried for a long time and several inventions had been developed and tried and failed (R. 24). Some of them were manufactured for a time (R. 24, 220) but none is now on the market except Waber type tubes (R. 22, 220).

In the effort to meet the public demand for a puncture resistant tube, some turned to a "compression type" tube (R. 23). None of these are now on the market, they had no protracted success. At the time of a big advertising campaign a good many would be sold for a period, but in sales, they all flattened out and the manufacturer would discontinue them (R. 23).

A Wallace tube is necessarily a failure, it will leak (R. 201). Further, Ternes, the respondents' expert, had never seen a tube made in accordance with Wallace (R. 86). The respondents do not sell a commercial Wallace tube; they sell Waber. They use the Waber method.

Crombie also was unsuccessful as was Wildman, for Ternes had never seen a tube made in accordance with these disclosures (R. 88, 89). Waber had never seen a successful tube of this type (R. 246). The respondents do not sell a commercial Crombie or Wildman tube. They use the Waber method.

After setting up several individuals and companies (R. 10) alleged to have known or used (R. 7) the Waber type

tube prior to Waber, the respondents failed to take supporting testimony. Presumably, these efforts too, were failures.

With this background of failures and broken dreams Waber himself embarked upon the solution of the problem. He started in 1924 (R. 21). In 1928 (R. 26) he was ready to manufacture the Waber tube. Waber, and he alone, succeeded.

He tried to have it built by all of the big companies, including the United States Rubber Company (R. 26). But even with the solution at hand, Waber was beset with difficulties. No one would build the tube, even if paid, because of bad experience in trying to build puncture proof tires (R. 26). Puncture proof tires were not a good thing to manufacture (R. 27). Finally, through the interest of Montgomery Ward, Waber was able to coax the Gillette Rubber Company into building a few hundred tubes (R. 26).

At first the tubes went to a few fleet operators (R. 26) to find out how they would actually perform in service (R. 28). Today the tubes are used on bicycles, automobiles, trucks, aeroplanes, industrial wheels and every place where pneumatic tires with inner tubes are used (R. 29). They are used by the Government, Illinois Bell Telephone Company, Marshall Field, Pure Oil, Kraft Cheese, Purity Baking Company, Ward Baking Company, United Parcel Delivery, Chicago Daily News, and a good many more (R. 29, 26, 41, 42, 256-258, 259-261). Many of these discriminating and careful users of pneumatic tubes have turned to the Waber tube practically exclusively (R. 41, 258, 261).

Every fleet that began to use the Waber tube does so almost exclusively at this time (R. 32).

The Waber tube attained an end not attained by anything in the prior art, and has been accepted as the termination of the struggle for a completely successful puncture sealing tube.

At first the trade scoffed at Waber's tube (R. 26, 27), but finally it started to manufacture by his method (R. 26, 28, 327, 328, 337). Successful Waber type tubes were manufactured and sold by the respondents, by Seiberling (R. 22) and by Waber. All are the Waber method (R. 296, 327-328, 335, 336, 337). They were the only successful puncture sealing tubes on the market.

Waber's sales rose from a few hundred in 1928 (R. 28) to 5,000-6,000 in 1930 (R. 31) to 200 a day for 1934 to 1941 (R. 35) and exceeded 100,000 by 1941 (R. 31). The respondents' sales for Waber type tubes were 30,000 for 1940 and 1941 (R. 123). In addition, Seiberling manufactured and sold Waber type tubes (R. 22, 283, 296). No prior art puncture sealing tube was successful (R. 220).

The tubes have sufficient merit that the War Production Board today permits the use of the additional rubber for tubes needed for heavy duty service (R. 35, 121).

Waber's success was beset with difficulties: First, no one wanted to make the tube (R. 26-27); Second, a Waber type tube sells at a premium price (R. 104-105); Third, Waber did not indulge in expensive advertising campaigns (R. 38), he sold his tubes on a trial basis (R. 31); and Fourth, Waber was competing with the large established manufacturers (R. 234, 22, 283).

Further evidence of invention arises from the fact that the respondents, after a thorough familiarity with the Waber method (R. 26, 28, 297, 298, and 149) and a study of several thousand patents (R. 55), began to follow Waber (R. 285, 123, 121, 283, 265, 327-328, 335-336, 337). They did not adopt any prior art tube or method. They accepted the benefit of the teachings of the Waber patent, and now assert that the teachings are worthless. They use the Waber method.

This Court and the several Circuits Court of Appeals have always considered such evidence to be impelling evidence that the discovery is patentable.

In preference to objective established tests, the Circuit Court of Appeals for the Seventh Circuit has held a patent invalid because someone else "could have duplicated" it. But the design of the patent laws is to encourage progress by granting the reward to the one who did it.

CONCLUSION.

In conclusion, the petitioner quotes from the Report of the National Patent Planning Commission:

"It would be highly desirable and a great step forward if patents could be issued with a greater assurance that their validity would be upheld by the courts. No other feature of our law is more destructive to the purpose of the patent system than this uncertainty as to the validity of a patent."

Petitioner earnestly prays that the petition for the writ of certiorari be grant, that the case be reviewed and that the decree of the Circuit Court of Appeals for the Seventh Circuit, finding invalidity of the Waber Patent No. 1,808,091, be reversed.

Respectfully submitted,

GEORGE I. HAIGHT,
M. K. HOBBS,
CARL HOPPE,

1041 Rookery Building,
209 South LaSalle Street,
Chicago 4, Illinois,

Attorneys for Petitioner.

Dated, Chicago, Illinois
August 10, 1945.

